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EXAMINER

GOTTSCHALK, MARTIN A

ART UNIT PAPER NUMBER

3694

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,339

Applicant(s)

MCCLURE ET AL.

Examiner

Martin A. Gottschalk

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. Claims 1-22 are pending. Claims 1, 2, and 5-22 are amended.

Claim Rejections - 35 USC § 112

2. The rejection in the first Office Action under this section are hereby withdrawn in view of Applicant amendment.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 3626

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-6 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor (PG Pub# US 2002/0010601) in view of McCormack et al (US Pat# 6,049,773) and further in view of Applicant's admitted prior art submitted in the disclosure for the current application (hereinafter APA).
 - A. As per claim 1, Taylor discloses a computer-implemented method for generating historical claim loss data reports that combine loss data from multiple insurance carriers over multiple years for an insured party comprising the steps of:
 - (a) inputting information about the insured party on a server (Taylor: inputting, [0008] – [0013]; [0045] – [0046]; Fig 2; server, [0066]; Fig 4, items 18 and 26));
 - (f) distributing the report to a user (Taylor: [0053]).

Taylor suggests but fails to explicitly disclose

- (c) querying loss data from a plurality of databases, wherein each database is maintained by a single carrier;

Art Unit: 3626

- (d) storing the queried loss data in a standard format;
- (e) generating a standardized report, wherein the report combines loss data from the plurality of databases.

However, these features are well known in the art as evidenced by the teachings of McCormack. McCormack discloses

- (c) querying loss data from a plurality of databases, wherein each database is maintained by a single carrier (McCormack: col 6, ln 58 to col 7; col 12, lns 61-65; Fig 3, items 100-500 show multiple databases which the Examiner notes are maintained by a single carrier, col 3, lns 47-52);
- (d) storing the queried loss data in a standard format (McCormack: col 7, lns 10-14; Fig 3, item 2000);
- (e) generating a standardized report, wherein the report combines loss data from the plurality of databases (McCormack: col 4, lns 24-28; col 23, lns 3-58).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of McCormack with the disclosures of Taylor with the motivation of utilizing the approaches of neural networks and

Art Unit: 3626

fuzzy logic (McCormack: col 3, Ins 25-37) to more efficiently match every tenant, owner, and insurance coverage (Taylor: [0021]) in the absence of complete information (McCormack: col 2, Ins 52-55).

Taylor suggests

- (b) obtaining an authorization to release information from the insured party (Taylor: claims 9 and 35, i.e. certain parties are “authorized” to receive tenant information);

However, Taylor and McCormack fail to explicitly disclose this feature that is well known in the art as evidenced by the teachings of APA (APA: pg 2, Ins 18-21).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the teachings of Applicant's admitted prior art with the combined teachings of Taylor and McCormack with the motivation of allowing more efficient and complete collection of tenant information in order to assure compliance with renter's agreements requiring a tenant to maintain insurance (Taylor: [0005]).

Note: In the claim rejections which follow, the motivation to combine the teachings of Taylor, McCormack, and APA is as provided above for claim 1.

Art Unit: 3626

B. As per claim 2, Taylor discloses the method according to claim 1, wherein the step of inputting the information about the insured party comprises

inputting the information about the insured through a user interface operatively connected to the server (Taylor: Figs 1-4. Note in Fig 3, user interface reads on item 12, which allows information to be input into item 10, a personal computer which subsequently inputs information into a server, reads on item 12. The line connecting 10 and 12 indicates an operative connection, see Taylor: [0047]-[0048]).

C. As per claims 3 and 4, Taylor discloses the method according to claim 1, further comprising the step of

(claim 3) implementing a security procedure that limits access to predetermined users.

(claim 4) receiving a Login Name from the user;

receiving a Password from the user; and

verifying that the received Login Name and Password have authorization to enter the secured area (applies to all the steps above for claims 3 and 4, Taylor: Fig 10; [0050] – [0051]; [0055]).

Art Unit: 3626

D. As per claim 5, Taylor discloses the method according to claim 1, wherein

before the step of inputting information about the insured party onto a server the user, through a user menu driven interface on the server, chooses a report request (Taylor: reports, [0056]; [0054] – [0055], insured reads on “user”. Note that information about a report can be requested at any time, both before and after user information is entered.).

E. As per claim 6, Taylor discloses the method according to claim 1, further comprising the step of

flagging an account as authorized on the server Website, wherein the account is flagged on the server after the step of obtaining an authorization to release information from the insured party is completed (Taylor: [0023], flagging and account reads on, “...generates...reports...listing...uninsured tenants...”; see also [0079]).

However, Taylor and McCormack fail to explicitly disclose the feature of obtaining an authorization to release information from the insured party, which is well known in the art as evidenced by the teachings of APA (APA: pg 2, Ins 18-21).

Art Unit: 3626

F. As per claim 11, McCormack discloses the method according to claim 1, wherein the step of querying loss data from the databases comprises the steps of:

triggering the query at pre-determined times (McCormack: col 7, Ins 21-40, the note that querying the LOSSTYPES, Fig 3, item 200 database occurs sequentially following the input of the Raw Claims Data, item 100. The Examiner considers this to be a form of a pre-determined time.);

and

querying only for the loss runs of flagged accounts (McCormack: col 10, Ins 20-24).

G. As per claim 12, McCormack discloses the method according to claim 11, wherein the step of querying loss data from the databases further comprises

determining an appropriate protocol according to which carrier database is queried (McCormack: col 7, Ins 21-40, note that the LOSSTYPES, CITY2LAT, and TEL2AT databases perform different functions, i.e. they perform according to different protocols, and these protocols are determined during the process when data is passed to the steps involving these databases.).

H. As per claim 13, McCormack discloses the method according to claim 1, wherein the step of storing the queried loss data in a standard format comprises the steps of:

selecting an appropriate mapping scheme according to the carrier database queried (McCormack: col 6, Ins 38-52, reads on "10 types of loss"; col 7, Ins 23-24);

mapping data fields of the carrier loss run data fields to fields in the standard format (McCormack: col 8, Ins 23-58);

and

adding additional fields to the standard format as needed (McCormack: col 8, ln 58 to col 9, ln 33).

I. As per claim 14, it is rejected for the same reasons provided for claim 1, step "e", i.e. the "generating" step.

J. As per claim 15, Taylor discloses the method according to claim 1, wherein the step of distributing the report to the user comprises the steps of:

Art Unit: 3626

inputting a notification list on the server (Taylor: [0021]; Fig 12);

emailing parties on the notification list upon completion of the report
(Taylor: [0021]; Fig 14, note the email address of recipient);

and

accessing the report by the parties on the notification list (Taylor: Fig 12).

K. As per claim 16, Taylor discloses the method according to claim 1,
wherein the step of distributing the report to the user comprises the steps of:

inputting a notification list on the server (Taylor: [0021]; Fig 12);

emailing parties on the notification list an URL address and a Password;

accessing the URL address;

inputting the Password;

verifying that the Password is an authorized Password;

Art Unit: 3626

and viewing the reports (for the last five steps, see Taylor: Fig 10; [0050] – [0051]; [0055]).

6. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of McCormack and APA, and further in view of Campbell (US Pat# 2001/0041993).

A. As per claim 7, the combined teachings of Taylor and McCormack teach the method according to claim 1, wherein the step of obtaining an authorization from the insured party comprises the steps of:

generating (from application software), printing and storing insurance - related information from an insured or potentially insured (Taylor: [0028] - [0029]) ;

and

collecting information from a user via a plurality of channels (Taylor: [0012] – [0013]);

The combined teachings of Taylor and McCormack fail to explicitly teach the above steps as applied to “authorization letters” which pertain to obtaining authorization from an insured to disclose loss data from the insured’s history,

Art Unit: 3626

however, these features are well known in the art as evidenced by APA (APA: pg 2, Ins 16-21).

The combined teachings of Taylor, McCormack, and APA fail to explicitly disclose the mechanics of performing some of the steps of claim 7, however, these features are well known in the art as evidenced by the teachings of Campbell, who discloses

generating authorization letters via the server (Campbell: [0040], the Examiner considers providing a release letter as an HTML form via a network browser to be a form of generating the letter via a server);

printing the authorization letters (Campbell: [0040]);

obtaining signatures of the insured party on the authorization letters (Campbell: [0040]);

returning the authorization (Campbell: [0040]) letters via facsimile (Campbell: [0028]; [0033]; [0038], note the teachings of faxing by a claimant as an alternative to mail.);

and

Art Unit: 3626

storing the authorization letters (Campbell: [0040]), reads on, "The release is held in escrow...").

It would have been obvious at the time of the invention to incorporate the teachings of Campbell with the disclosures of Taylor, McCormack, and APA with the motivation of decreasing the cost of processing insurance claims (Campbell: [0005]).

B. As per claim 8, Taylor discloses the method according to claim 7, wherein the step of printing the authorization letters comprises the user printing the authorization letters which have

unique tracking numbers (Taylor: [0012], the Examiner the disclosing coding to include a unique tracking number for a tenant)

or

bar codes.

C. As per claim 9, APA discloses the method according to claim 7, wherein the step of storing the authorization letters comprises

Art Unit: 3626

routing the authorization letters according to account to storage areas (APA: pg 2, ln 21, reads on "...very labor intensive." The Examiner considers routing the letters to include for example the labor-intensive practice of receiving the faxed documents and filing them.).

D. As per claim 10. Taylor and McCormack discloses the method according to claim 9, wherein the step of storing the authorization letters further comprises the steps of:

interfacing the routing system and the server (Taylor: Fig 4, items 20 and 22; [0049]);

and

flagging the account on the server when the routing system has received all of the authorization letters for the account (McCormack: col 10, lns 20-24).

7. As per claims 17-22, they are system claims which repeat the same limitations of claims 1, 3, 8-10 and the corresponding method claims, as a collection of elements as opposed to a series of process steps. Since the teachings of Taylor, McCormack and APA disclose the underlying process steps that constitute the methods of claims 1, 3, and 8-10, it is respectfully submitted

Art Unit: 3626

that they provide the underlying structural elements that perform the steps as well. As such, the limitations of claims 17-22 are rejected for the same reasons given above for claims 1, 3, and 8-10.

Response to Arguments

8. Applicant's arguments on pages 8-12 in the response filed 06/02/2006 have been fully considered but they are not persuasive. They will be addressed approximately in the order in which they are presented in the response.

A. Beginning in the second paragraph on pg 10, and through the first full paragraph of pg 12 of the response, Applicant argues that there is no motivation to combine the applied references, Taylor and McCormack, and indeed, Taylor teaches away from such a combination.

In response, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, the examiner asserts that it is not necessary that a reference actually suggest changes or possible improvements which the applicant made, as stated in In re Sheckler, 168 USPQ 716 (CCPA 1971). The Patent & Trademark Office can satisfy the burden under § 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to

Art Unit: 3626

one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fine, 5 USPQ2d 1596, 1598 (CA FC 1988). Therefore, the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971).

In the present case, Applicant is referred to the motivation to combine these references provided for claim 1. As provided, Taylor clearly suggests the existence of incomplete information, and McCormack suggests the need to address such a situation, as well as the ability of the disclosed system to do so.

In response to the argument that the Taylor reference teaches away from examiner's interpretation, examiner asserts disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. In re Susi, 169 USPQ 423, 426 (CCPA 1971). In the instant case, the fact that Taylor discloses preparing incomplete data into a report so that a person can provide the missing information in no way precludes attempting to reduce the amount of missing information in the first place, such as incorporating the teachings of McCormack into the system of Taylor.

At the top of page 12, Applicant appears to argue that the level of skill in the art was relied upon to provide the suggestion to combine the references. Again, Applicant is referred to the above paragraphs and to the motivation provided in claim 1 which demonstrates the suggestion to combine the references is provided by the references themselves.

Art Unit: 3626

B. Beginning on pg 12 through pg 13, Applicant appears to argue the combined references of Taylor and McCormack do not teach the limitations of amended claim 1. To begin with, Applicant initially asserts on pg 12 the references do not teach querying loss data from databases maintained by different carriers. In response, it should be noted that claim 1 does not mention the specific phrase “different carrier,” thus the references are not required to meet this limitation. On pg 13, Applicant correctly states the claim language as recites querying from a plurality of databases maintained by a single carrier. In response, Applicant is directed to the passages cited above in the rejection of claim 1 wherein it is noted that the reference discloses querying loss data from a plurality of databases, each database maintained by a single carrier. Note that *the single carrier is the entity maintaining all of the databases.*

C. Beginning on pg 13 and on to pg 14, Applicant further argues the limitation of “obtaining an authorization” is not met. This argument is moot due to new grounds of rejection necessitated by amendment.

D. On pg 16, Applicant points out that the heading of “Background” in the specification is for organizational purposes apparently to disavow statements made there as being admissions of prior art. While the organizational nature of headings is generally acknowledged, the Examiner respectfully disagrees with any conclusion that the disclosed content does not constitute admitted prior art. Upon re-inspection of the cited disclosures that were used in the first Office

Art Unit: 3626

Action, it is concluded that they were applied appropriately. The Examiner further notes that the Campbell reference has been brought in, necessitated by amendment, in order to demonstrate how the prior art meets several of the amended limitations formerly rejected solely on the basis of the admitted prior art.

E. In the response to the argument at the bottom of pg 16 regarding claim 17, just as Applicant applies the preceding arguments concerning claim 1 to claim 17, so does the Examiner apply the responses to these arguments.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

Art Unit: 3626

the statutory period for reply expire later than SIX MONTHS from the date of this final action.

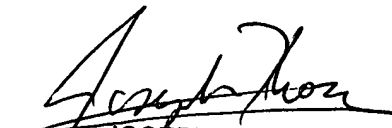
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Thurs 8:30 -6 and alternate Fri 8:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MG
08/15/2006



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